

REMARKS

In response to paragraph 2 of the subject Office Action, claim 16 is listed in the present Amendment as "Previously Presented" to reflect that it was previously amended.

In addition, regarding the Examiner's rejections of claims 8 and 10 in paragraph 3 of the subject Office Action, the phrase "or other machine readable indicium" has been deleted from claim 8 while the phrase "or another biometric device" has been deleted from claim 10 by the present Amendment. As a result, Applicant respectfully submits that all claims are now proper under 35 U.S.C. 112.

In paragraph 4 of the subject Office Action, claims 1, 7-11 and 16-18 have been rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,157,726 to Merkle et al. in view of U.S. Patent No. 5,671,282 to Wolff et al. Applicant respectfully traverses the Examiner in this regard.

Independent claim 1 of the application recites the step of "generating verification data from the user data and the document data." Independent claim 16 similarly recites as an element "processor means for generating verification data derived from the document data and the user data." Neither Merkle nor Wolff, alone or in combination, disclose this step and element of claims 1 and 16, respectively.

Merkle provides a system and method for authenticating a hard copy of an original document that uses a "signing copier" machine which applies a digital signature to the copy. As explained in column 6, lines 52-58, at the receiving end, the copy of the document bearing the digital signature is checked for validity using a second "signing copier." The Examiner states that the digital signature is "verification data." In contrast to the invention recited by

independent claims 1 and 16, however, the digital signature of Merkle is not generated using document data.

As explained in column 6 of Merkle, lines 41-51, and illustrated in Fig. 3, a smart card carrying data identifying the user is swiped through card input 51. At block 62 of the “signing copier” machine, the data from the smart card is used to generate a digital signature which is affixed to the optical copy of the document at block 64. A timestamp may be included in the digital signature to indicate the date and time when the signed document was produced. As illustrated at 20 and 54 in Fig. 3 of Merkle, the original document is copied and then the signature, after generation, is applied to the copy of the document. Applicant respectfully submits that document data is therefore not used to generate the digital signature/verification data of Merkle.

Applicant respectfully submits that Wolff does not cure the above shortcoming of Merkle. As described in column 7, lines 24-43, a user (such as a physician) uses a server subsystem to generate a document such as a prescription. An electronic copy of the prescription is stored on the server subsystem, which is accessible by a client system. The recipient of the document (such as a patient) takes the prescription to a pharmacy where the prescription is scanned by the client subsystem (such as by a pharmacist). The client subsystem contacts the server subsystem and verifies that the document/prescription is valid, that it has not already been filed and that no new/conflicting instructions or prescriptions have been issued. As a result, the system of Wolff does not generate verification data using data of a user authorized to access the system. Indeed, the system of Wolff does not generate verification data at all. It merely generates a document and the entire contents of the document are later compared to the document via the server and client subsystems for verification. In the present invention, only the

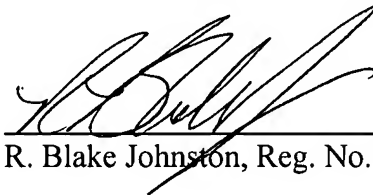
verification data need be scanned from the presented document and compared with the authentication record, which does not comprise the entire document. This is a more efficient and less complex approach than that of Wolff.

As a result, Applicant respectfully submits that independent claims 1 and 16, and the claims that are dependent thereon, are patentable over the cited references.

In view of the foregoing amendments and remarks, it is believed that the application is in condition for allowance and such action is respectfully requested.

If the Examiner believes that a telephone conference would advance the prosecution of the case, it is requested that the undersigned attorney be telephoned for that purpose.

Respectfully submitted,



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